

### REMARKS

This responds to the Office Action mailed on October 18, 2007.

Claims 1, 15 and 24 are amended; no claims are canceled in this response, and no claims are added; as a result, claims 1-6, 10-11, 15-19, 21, 24-29 and 33-34 remain pending in this application.

#### §102 Rejection of the Claims

Claims 1, 3, 5-6, 10-11, 15-16, 18, 21, 24, 26, 28-29 and 33-34 were rejected under 35 U.S.C. § 102(b) for anticipation by Hoyle Casino on Game Boy Color (<http://gameboy.ign.com/articles/164/164559p1.html>; hereinafter “Hoyle Casino”). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P* § 2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that claims 1, 3, 5-6, 10-11, 15-16, 18, 21, 24, 26, 28-29 and 33-34 as amended contain elements not found in Hoyle Casino.

For example, claims 1, 15 and 24 as amended recite a wagering game having a first portion with first output media and a second portion with second output media where the first portion is displayed on a primary display and the second portion of the wagering game is displayed at the request of the gaming control unit on a display associated with a media control unit comprising an adapted video game system. As an example, a first portion of a wagering

game may be a base wagering game controlled by the gaming control unit, where first output media of the base wagering game may be displayed on a primary display until the gaming control unit determines that a bonus event has occurred. Upon the occurrence of the bonus event, the gaming control unit may request the adapted video game system to display second output media associated with the different second portion of the wagering game (e.g., a bonus game).

The above described operation recited by the claims is different from the operation that appears to be described in Hoyle Casino. In Hoyle Casino, all players that are playing on linked machines are participating in the same portion of the wagering game (e.g. the same round of poker, the same roulette game, or the same round of blackjack). There is no disclosure in Hoyle that a first portion of a game is displayed on a first display and a different second portion of the wagering game is displayed on a display of an adapted video game system at the request of a gaming control unit.

Further, claim 15 recites “a set of one or more user input devices coupled to the gaming control unit and operable to provide user input to the gaming control unit for use in presenting the first portion of the wagering game and the second portion of the wagering game, wherein user input is received exclusively through the set of one or more user input devices.” In Hoyle, there are multiple sets of input devices coupled to multiple gaming control units (e.g. one set of input devices for each Game Boy), where each set of input devices is used to control the Game Boy to which it is attached. In cooperative game play, each display is updated in accordance to both the user input received by the devices attached to the video game and by input received on other attached systems. In contrast, claim 15 recites a single set of input devices coupled to the gaming control unit which is used to provide exclusive user input for both a first portion of a wagering game displayed on a primary display and a second portion of a wagering game presented on an adapted video game system at the request of the gaming control unit.

Thus Applicants’ claims recite an integrated wagering game device and methods for controlling such a device where a gaming control unit determines where media for portions of a wagering game is displayed and under what conditions that the gaming control unit will request an adapted video game system to display media associated with a different second portion of a

wagering game. This is different from the mere linking of multiple video game systems where each participant sees a view of the same portion of the video game.

For the reasons discussed above, claims 1, 15, and 24 recite elements that are not found in Hoyle Casino. Further, the elements recited in claims 1, 15 and 24 are arranged differently than in Hoyle Casino. As a result, Hoyle Casino does not anticipate claims 1, 15 and 24. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 15 and 24.

Claims 3, 5-6 and 10-11 depend from claim 1. Claims 16, 18, and 21 depend from claim 15. Claims 26, 28-29 and 33-34 depend from claim 24. These dependent claims inherit the elements of their respective base claims and are therefore not anticipated by Hoyle casino for at least the reasons discussed above regarding their respective base claims. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 3, 5-6, 10-11, 16, 18, 21, 26, 28-29 and 33-34.

#### §103 Rejection of the Claims

Claims 1, 3-6, 10-11, 15-16, 18-19, 21, 24, 26-29 and 33-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over IGN Staff (Xbox Specs) as evidenced by Xbox.com (Xbox LAN Parties: Using System Link, hereinafter “Xbox LAN Parties”) in view of one of ordinary skill.

Claims 2, 17 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Varanini (“TimeSplitters 2 to support system link”, hereinafter “TimeSplitters”) as evidenced by Lee (“iLink setup FAQ”).

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

As discussed above, claims 1, 15 and 24 as amended recite a wagering game having a first portion with first output media and a second portion with second output media where the first portion is displayed on a primary display and a different second portion of the wagering game is displayed at the request of the gaming control unit on a display associated with a media control unit comprising an adapted video game system.

In general, each of Xbox Specs, Xbox LAN Parties, Time Splitters and iLinksetup FAQ and combinations thereof is believed to operate similarly to Hoyle Casinos discussed above in that the same portion of a game is played and viewed simultaneously by all players and systems participating in the game, with each player controlling an aspect of the game (e.g., character actions etc.) with input devices on the player's video game system. Thus none of the cited references, alone or in combination, discloses a system in which a first portion of a game is displayed on a first display and a second portion of the game is displayed on a display controller by an adapted video game system and at the request of a gaming control unit as recited in claims 1, 15 and 24 as amended.

Further, claim 15 recites a gaming device in which a single set of user input devices coupled to a gaming control unit is used to provide user input for the first and second portions of the wagering game, where the gaming control unit displays a first portion of the wagering game on a primary display and requests an adapted video game system to display media associated

with a second portion of the wagering game. This is different from the systems described in Xbox Specs, Xbox LAN Parties, Time Splitters and iLinksetup FAQ in which multiple sets of input devices associated with multiple video game systems is used to participate in the same portion of a game.

In view of the above, there are critical differences between claims 1, 15 and 24 and any combination of Xbox Specs, Xbox LAN Parties, Time Splitters and iLinksetup FAQ. Thus claims 1, 15 and 24 are not obvious in view of the cited references, alone or in combination. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 15 and 24.

Claims 2-6 and 10-11 depend from claim 1; claims 16-19 and 21 depend from claim 15; and claims 25-29 and 33-34 depend from claim 24. These dependent claims inherit the elements of their respective base claims are therefore allowable for at least the same reasons as discussed above regarding their respective base claims 1, 15 and 24. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 2-6, 10-11, 16-19, 21, 25-29 and 33-34.

#### *Patentable Weight Given to Claim Elements*

Applicant notes that in the rejection under 35 U.S.C. 102, the Office Action makes that statement that the “Office firmly believes the claim limitations that contain patentable weight in these claims have been addressed with the rejection provided above.” However, the Office Action does not identify any portions of the claims have not been given patentable weight. If the Office is not giving patentable weight to any portion of the claims, Applicant respectfully requests that the Office identify the specific claim language that is not given patentable weight so that the Applicant has a meaningful opportunity to respond.

#### **Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of

the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

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By

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 18 day of April 2008.

Name

Signature